

REMARKS

In the Final Office Action, the Examiner rejected claims 1-4, 16-21, 29-35, 54-58, 63-65, and 74-76. Additionally, Applicants note that claims 6-15, 22-28, 36-45, 50-53, 59-62, and 66-73 remain withdrawn from consideration. Applicants respectfully reserve the right to request rejoinder of these withdrawn claims at an appropriate, later time. Applicants have not amended the claims of this application by this response. In summary, claims 1-5, 16-21, 29-35, 46-49, 54-58, 63-65 and 74-76 remain pending in the present patent application. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections Under Section 103

In the Final Office Action, the Examiner rejected all of the pending claims under 35 U.S.C. § 103(a) as obvious in view of various combinations and permutations of the Fabian et al. reference (U.S. Patent No. 5,915,985; hereinafter “Fabian”), the Heberlein, Jr. et al. reference (U.S. Patent Appl. Pub. No. 2003/0051175 A1; hereinafter “Heberlein”), and the Wu reference (U.S. Patent No. 6,447,340; hereinafter “Wu”).

A. Legal Precedent

Applicants, however, respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to the present claims. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In other words, the Examiner—not Applicants—bears the burden of establishing the threshold requirements for a *prima facie* case of obviousness. To establish this *prima facie* case, the Examiner must show two things. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must first show that the combination or modification includes *all* of the claimed elements. *See id.* Additionally, the Examiner must present a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in

light of the teachings of the references. *See id.* If either element is missing, the rejection cannot stand.

Moreover, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Indeed, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, long-standing precedent requires presenting a Section 103 rejection, an Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). “Broad conclusory statements standing alone are not ‘evidence’.” *In re Kotzab*, 55 U.S.P.Q. 2d 1314, 1317 (Fed. Cir. 2000).

Thus, when prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification *other than the hindsight* gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Indeed, the Federal Circuit has warned that the Examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See In re Dembiczak* 50 U.S.P.Q. 2d 52 (Fed. Cir.1999). (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir.1983)). Moreover, avoiding hindsight reconstruction is especially important regarding less technologically complex inventions,

where the very ease which the invention can be understood may prompt one to employ such hindsight. *See id.*

As discussed above, in determining the differences between the prior art and the claims, the question under Section 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983). Thus, the Examiner must not look at each element of a claim individually, but rather the claims should be viewed as a tapestry comprising the recited elements. Thus, "it is impermissible, however, to simply engage in a hindsight reconstruction of the claimed invention, *using the applicant's structure as a template* and selecting elements from references to fill the gaps." *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Simply put, what may seem logical to combine in retrospect and after viewing an applicant's invention is not obvious unless the cited references, without benefit of this hindsight, teach what is claimed. *See In re Zurko*, 42 U.S.P.Q.2d 1476, 1479 (stating "[w]hile in retrospect, looking at applicants' invention, it might seem logical to perform a repeat-back in the UNIX system over a trusted line, neither UNIX nor FILER2 teaches communications with the user of a trusted pathway," as is recited in the claim in question). In summary, a valid Section 103 rejection must articulate and support with objective evidence a line of reasoning that establishes why one of ordinary skill in the art, with no knowledge of an applicant's intention, would make the combination in the manner claimed. *See In re Kotzab*, 55 U.S.P.Q. at 1318 (Fed. Cir. 2000).

With the foregoing legal precedent in mind, Applicants respectfully assert that the pending claims are not obvious in view of the cited references, whether taken alone or together.

B. First Rejection Under Section 103

In the Final Office Action, the Examiner rejected claims 1-4, 16-21, 29-33, 46-49, 54-58, 63, 65, and 74-76 under 35 U.S.C. § 103(a) as obvious in view of Fabian and Heberlein. Specifically the Examiner stated as follows:

Fabian discloses an electrical component system comprising an enclosure 10, main power conductors 20 disposed in the enclosure 10, secondary power conductors 24 disposed in the enclosure 10, a component assembly 14 including a component support and at least one component mounted on the support, a main power connector 22 disposed on the support and adapted to connect with the main power conductors 20, a connector assembly 32 disposed on the support and adapted to connect with the second conductors 24. Fabian teaches that the component assembly 14 includes *circuit breakers*. Fabian also teaches that the component assembly 14 has three positions. A first position is known as the disconnect position, wherein the main power connector 22 and the connector assembly 32 of the component assembly 14 is disconnected with the main power conductors 20 and the secondary power conductors 24. A second position (service position) is known as the testing position, wherein the main power connector 22 of the component assembly 14 is disconnected with the main power conductors 20 while the connector assembly 32 of the component assembly 14 is connected with the secondary power conductors 24. A third position is known as the connect position, wherein the main power connector 22 and the connector assembly 32 of the component assembly 14 is connected with the main power conductors 20 and the secondary power conductors 24, respectively. However, Fabian does not disclose network data conductors disposed in the enclosure.

Heberlein, Jr. discloses an electrical component system 10 comprising main power conductors 20, secondary power conductors 22, and network data conductors (networked devices) 18. The network system 10 applies the secondary power to the network data conductors 18 in the event of an interruption or malfunction in the main power conductors 20. Heberlein, Jr. teaches that the networked devices 18 includes switchgear, motor controllers, motor starters, *circuit breakers*, logic controllers, monitoring stations, and so forth (see the paragraph [[0022], lines 8-14). Also, the secondary power conductors 22 can be AC or DC power (the paragraph [00281]).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include networked devices as taught by Heberlein, Jr. to the electrical component system taught by Fabian because Heberlein, Jr. teaches that a circuit breaker is a type of networked devices.

See Final Office Action mailed October 21, 2005 (hereinafter "FOA"), pp. 2-3.

Additionally, the Examiner, in reply to Applicants' previous arguments stated as follows:

The applicant only argues about the reference by Fabian et al (US 5,915,985), but not the secondary references by Heberlein, Jr. et al (US Patent Application Publication No. 2003/0051175 A1) and Wu (US 6,447,340). The examiner believes that various combinations of the references by Fabian, Heberlein, Jr. and Wu clearly disclosed and taught the limitations recited in the claimed invention as described in the previous office action. Since the applicant did not argue why the secondary references are not appropriate, the applicant's arguments are not persuasive. Thus, the examiner will maintain the rejections stated in the previous office action.

FOA, pp. 4-5.

Applicants, however, respectfully disagree for at least two reasons. First, the Examiner has not shown that the cited references, whether taken alone or in combination, disclose all of the features recited in the pending claims. Secondly, Applicants respectfully submit that even if, *arguendo*, it is accepted that *all* of the claimed elements are disclosed, an objectively supported motivation for combining the cited references to reach the pending claims has not been presented. For these two reasons, which are discussed further below, Applicants submit that a *prima facie* case of obviousness has not been established and, as such, the present claims are patentable and in condition for allowance.

I. The cited references do not disclose all of the claimed features.

As discussed in the previous response, Applicants respectfully again submit that the cited references do not disclose all of the claimed features.

i. Independent Claim 1 and the Claims Depending Therefrom

For example, Applicants respectfully submit that the cited references do not disclose “a connector assembly” that meets *all* of the following structural characterizes recited in independent claim 1: 1) “disposed on the component support;” 2) “adapted to be coupled to the component assembly;” 3) *and “adapted to complete an electrical connection between the component assembly and the secondary power and network data conductors upon engagement of the component assembly in the enclosure.”* (Emphasis added.)

In the previous response, Applicants focused on the Fabian reference, which, in contrast to the instant claim, discloses connectors 22 and 32 that couple *only to a single source of power*—not to main power and second power conductors, as recited. In Fabian, the primary connector 22 is mated with the connector 20 secured to the cabinet to couple the circuit break 14 to upstream power, while the connector 32 mates with connector 26 of the cabinet to transfer this upstream power through the circuit breaker 14 to the downstream components in the cabinet. *See* Fabian, col. 2, ll. 55-65; col. 3, ll. 15-17; col. 3, ll. 25-30; *see also* Applicants’ Response mailed October 3, 2005, pp. 17-18. Simply put, Fabian is devoid of any reference to a secondary power. Thus, at no point, is any connector of Fabian adapted to complete an electrical connection...[to] secondary power, as recited.

The Examiner, however, in reply to this argument and without addressing the substance of Fabian, simply posits that “various combinations of the references by Fabian, Heberlein, Jr. and Wu clearly disclosed and taught all the limitations recited in the claimed invention as described in the previous office action.” FOA, pp. 5-6. However, the Examiner’s argument, as quoted above, makes no mention, let alone demonstration, of what

component in Heberlein is anticipatory of or could be equated with the claimed connector assembly. Indeed, the entire paragraph in which Heberlein is discussed fails to include the words “connector assembly,” which is the focus of Applicants’ arguments.

Accordingly, the Examiner cannot establish *prima facie* case of obviousness without articulating and demonstrating how Heberlein discloses the claimed subject matter. As the Examiner will appreciate, an examiner’s action must be “complete as to all matters.” 37 C.F.R. § 1.104(b). Indeed, the M.P.E.P. states that “[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the Examiner during prosecution of an application.” M.P.E.P § 707.07(f). Moreover, 37 C.F.R. § 1.104(c)(2) requires that “[t]he pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” Additionally, this section states “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as clearly as possible.” See 37 C.F.R. § 1.104(c)(2). Thus, without clear citation, Heberlein cannot be employed to reject specifically recited subject matter of the present claims.

Furthermore, even if, *arguendo*, Heberlein is admitted, this reference fails to disclose any semblance of a connector assembly. Although Heberlein does discuss secondary power, nothing in the Heberlein suggests, let alone discloses, a connector assembly as recited. Indeed, the mere fact that Heberlein discloses a circuit breaker does not establish that a connector assembly having the three distinct structural features delineated above is disclosed. A mere suggestion of a claimed element is not sufficient disclosure to provide disclosure related to a claimed element. See *In re Robinson*, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999) (noting that the cited reference in the case in question merely suggested a claimed feature).

**ii. Independent Claims 16, 29, 54, 63, and 74
and the Claims Depending Therefrom**

Additionally, Applicants respectfully submit that the cited references do not disclose all of the features recited in independent claims 16, 29, 54, 63, and 74. For example, these claims recite as follows:

Claim 16: “a component assembly...*positionable* in an operational position in which the component assembly is electrically connected to the main power conductors and to the secondary and network data conductors, respectively, and *a service position in which the component assembly is electrically disconnected from the main power conductors but remains electrically connected to the secondary power and network data conductors* to receive secondary power and network data;”

Claim 29: “a component assembly... *positionable* between an operational position in which the component assembly is electrically connected to the main power conductors and to the secondary power conductors and the network data conductors, and *a service position in which the component assembly is electrically disconnected from the main power conductors but remains electrically connected to the secondary power conductors and the network data conductors to receive second power and network data*, and a disengaged position wherein the component assembly is disengaged from the main power conductors, the secondary power conductors, and the network data conductors;”

Claim 54: “*moving* the component assembly from an operational position in which the component assembly is electrically connected to the main power conductors and to the secondary power and network conductors to *a service position wherein in which the component assembly is electrically disconnected from the main power conductors but remains electrically connected to the secondary power and network data conductors* to receive secondary power and network data;”

Claim 63: “*moving* the component assembly from a service position in which the component assembly is

electrically disconnected from the main power conductors but remains electrically connected to the secondary power conductors and the network data conductors to receive secondary power and network data, to a disengaged position in which the component assembly is disengaged from the main power conductors, the secondary power conductors and the network data conductors;”

Claim 74: “a component assembly ... *positionable* in a first position in which the component assembly is electrically connected to the main power conductors and to the secondary and network data conductors, respectively, and a *second position in which the component assembly is electrically disconnected from the main power conductors but remains electrically connected to the secondary power and network data conductors to receive secondary power and network data*, wherein the at least one component is at least partially operable via secondary power from the secondary power conductors.

(Emphasis added.) And these features are not disclosed by the reference combination.

As discussed above, in Fabian, *movement or positioning* of the alleged component assembly, i.e., circuit breaker 14, disconnects the circuit breaker 14 from all sources of power. Thus, the device of Fabian is not *positionable* in a service position, where the service position retains secondary power to the circuit breaker 14. Instead, the circuit breaker 14 of Fabian is positionable between only two states: a fully operational state and a fully deactivated state.

Additionally, noting in Heberlein obviates this deficiency of Fabian. Although Heberlein discloses various devices 18, one of which may be a circuit breaker, nothing in this reference suggests that these devices are *positionable or can be moved*. Indeed, it is wholly speculative to assume that the devices of Heberlein are not *fixed in place*. Again, a mere suggestion of a claimed element is not sufficient disclosure to provide disclosure related to a claimed element. *See In re Robinson*, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir.

1999) (noting that the cited reference in the case in question merely suggested a claimed feature).

Furthermore, even if one were to “to include networked devices as taught by Heberlein, Jr. to the electrical component system taught by Fabian,” as the Examiner suggests, this modified device would still not present an assembly that has a service position as claimed. Rather, each of the devices of Heberlein—whether a circuit breaker, a controller, or a motor starter, etc.— would have only two operating positions (on or off) if substituted for the circuit breaker 14 of Fabian. That is, as discussed above, the circuit breaker 14 of Fabian has only two operating positions, thus lacking any semblance of a service position as claimed. Accordingly, if one were to replace this circuit breaker 14 of Fabian with the list of devices described in Heberlein, this replaced device too would only have two operational states, on and off. Moreover, because Fabian discloses a circuit breaker 14 as the positionable device, it teaches that only power source to the system is to be disconnected when the circuit breaker is moved to the alleged service position. Thus, the Examiner’s reference combination also fails to reach all of the claimed subject matter.

II. A proper motivation for combination has not been presented.

Furthermore, even if, *arguendo*, it is accepted that the cited references disclose all of the claimed features, Applicants respectfully submit that an objectively supported motivation for combining the references to reach the pending claims has not been presented. As quoted above, the motivation presented by the Examiner for combining Fabian with Heberlein is as follows: “It would have been obvious...to include networked devices as taught by Heberlein, Jr. to the electrical component system taught by Fabian because Heberlein, Jr. teaches that a circuit breaker is a type of networked devices.” However, no *objective evidence* is presented to support this assertion. That is, the Examiner has not shown *why* one of ordinary skill in the art would have been motivated to make the cited reference combination. Rather, it appears that the Examiner has simply asserted that it

could be done with Applicants' disclosure in mind. Such a rejection employees impermissible hindsight, and is insufficient to support a *prima facie* case of obviousness.

III. Conclusion

Therefore, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for independent claims 1, 16, 29, 54, 63, and 74. Therefore, Applicants respectfully request reconsideration and allowance of these claims and their respective dependent claims.

B. Second Rejection Under Section 103

In the Final Office Action, the Examiner rejected dependent claims 5, 34, 35, and 64 under Section 103 as obvious in view of Fabian, Heberlein, and Wu. Applicants, however, respectfully submit that the addition of Wu does not obviate the deficiencies of Fabian and Heberlein, as discussed above in relation to the independent claims from which dependent claims 5, 34, 35, and 64 respectively dependent. Accordingly, Applicants respectfully submit that the foregoing dependent claims are patentable not only by virtue of their respective dependencies upon allowable base claims but also by virtue of the additional features recited therein. In view of the foregoing, Applicants respectfully request reconsideration and allowance of dependent claims 5, 34, 35, and 64.

Conclusion

In view of the foregoing remarks, Applicants urge the Examiner to contact the Undersigned to discuss the advancement of the pending claims to substantive prosecution. Indeed, a short teleconference between the Undersigned and the Examiner will significantly advance prosecution of the pending claims, which are believed to be patentable and in condition for allowance.

Respectfully submitted,



Date: December 21, 2005

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